

Appl. No. 09/385,336

Responsive to the Office Action Dated November 19, 2002

REMARKS

This is responsive to the Office Action dated November 19, 2002 in which claim 7 was allowed and claims 8 and 39 were merely objected to as being dependent upon a rejected base claim but otherwise be allowable if rewritten in independent form. Applicants greatly appreciate the indication of allowance of these claims over the prior art of record. In response to the objection to claims 8 and 39, Applicants have amended each of those claims to be placed in independent form to include all the limitations of the associated base claim and any intervening claims. Consequently, Applicants respectfully request allowance with respect to these claims. Claims 2 and 38 have been amended to depend from claims 8 and 39, respectively. As such, they are likewise in condition for allowance.

With respect to the prior art rejections, claims 2 and 35 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,290,033 issued to Bittner et al. Claim 35 has been cancelled herewith and as previously stated, claim 2 has been amended to depend from claim 8. As a result, Applicants respectfully assert that the § 102 rejections based on Bittner et al. have been overcome.

Claims 37 and 38 were rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over Bittner et al. in view of U.S. Patent No. 5,222,624 issued to Burr. Applicants have cancelled claim 37 and as previously indicated claim 38 has been amended to depend from claim 39. As a result, Applicants respectfully

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assert that the § 103 rejections based upon the combination of Bittner et al. and Burr have been overcome.

Claims 41, 44, 45, 47 and 48 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,454,973 issued to Irvine. Additionally, claims 42, 43 and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Irvine. Claim 41 has been cancelled herein. Claim 43 has been amended to be placed in independent form to include the subject matter of claim 41. Claims 42, 44 and 45 have been amended herein to depend directly from claim 43. Claim 46 has not been amended herein and claims 47-48 have been amended to be placed in dependent form and depend directly from claim 46. As such, claims 42-48 remain pending and each has been rejected based on Irvine as being anticipated by or obvious in view of that reference. Of those claims, claims 43 and 46 are independent claims with claims 42, 44-45 and 47-48 depending from one of those independent claims. Applicants respectfully assert that independent claims 43 and 46 as well as claims dependent therefrom are both patentably nonobvious and novel with respect to Irvine alone or in combination with the other art of record for at least the following reasons.

The Office Action in paragraph 9 acknowledges that Irvine fails to disclose a controller. Claims 43 and 46 each recite a controller; therefore, Applicants respectfully assert that the § 102 rejections based on Irvine have been rendered moot because claims 42-48 each recite the controller either directly or based upon dependency from an independent claim reciting such a feature.

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With respect to the obviousness rejections based upon Irvine, the Office Action indicates that "The Examiner takes Official Notice that such bursting configurations with controllers are old and well known in the art and . . . it would have been obvious to one having ordinary skill in the art to provide a controller on the device of Irvine." Applicants respectfully traverse the rejections of these claims and challenge the Official Notice in the rejections. Therefore, Applicants respectfully demand evidence proving the alleged prior art of the Official Notice cited in the Office Action with respect to Irvine.

In this regard, Applicants would like to note the admonition provided by the CCPA on this point:

[T]his court will always construe [the rule permitting judicial notice] narrowly and regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom. Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. *Cf. In re Cofer*, 53 CCPA 830, 354 F.2d 664, 148 USPQ 268 (1966), *In re Borst*, 52 CCPA 1398, 345 F.2d 851, 145 USPQ 554 (1965). Allegations concerning specific "knowledge" of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge. *See In re Spormann*, 53 CCPA 1375, 363 F.2d 444, 150 USPQ 449 (1966). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982) citing *In re Ahlert*, 57 CCPA 1023, 1027, 424 F.2d 1088, 1091, 165 USPQ 418, 420-21 (1970).

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Additionally, the controller recited in claims 42-48 is operably coupled to the first and second ticket drive devices to inactivate those devices and hold the ticket strip stationary during separation of the adjacent tickets by the rotary separator member. This operation of the controller is distinctly different from the operation of the device disclosed in Irvine. As a result, Applicants respectfully assert that one of ordinary skill would not consider Irvine a relevant reference for a combination as described in claims 42-48 in which the controller holds the drive devices stationary during ticket separation. In fact, Irvine specifically states on numerous occasions that the bursting device disclosed therein is to be utilized with drive devices having differing speeds during the separation to produce tension on the web. ("This burster can be easily and conveniently adapted for use in any of the prior art systems having roller speed differential." Col. 3, Ins. 67 through Col. 4, In. 1; "Since there is a pulling effect upon paper web 8 because of the roller speed differential and the positioning of the bursting mechanism 1 along the web or paper path, the paper will follow the outline of the cones 2 and 3 and because of the bursting tension formed will separate at its weakened portions or perforations." Col. 4, Ins. 21-27; "Since the speed of burst rollers 13 exceeds the speed of feed rollers 12 . . . a pulling action is imparted to form web 8 causing the web to hug the contours of the cones 2 and 3 and tear along its weakened portions. The preferred speed differential is when the burst rollers 13 are traveling at about twice the linear speed of the forms feed rollers 12." Col. 4, Ins. 38-45.) Moreover, claims 42-48 each recite a rotary separator member; however, in one

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embodiment of the invention disclosed in Irvine, the alleged separator member is fixed and locked in position during the separating operation. (See Col. 5, Ins. 1-3.)

As such, Applicants respectfully assert that one of ordinary skill in the art would not consider Irvine or modifications of the device shown in Irvine because that reference teaches away from the invention of Applicants' claims 42-48. The Supreme Court has held that one important indicia of nonobviousness is "teaching away" from the claimed invention by the prior art. *U.S. v. Adams*, 383 U.S. 39, 148 USPQ 479 (1966). Teaching away from the art is a per se demonstration of a lack of *prima facie* obviousness (*See In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986) and *In re Nielson*, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987)).

The Irvine device relies upon a moving web with differing roller speeds to create tension over a fixed position bursting device. In contrast, Applicants' invention of claims 42-48 requires a controller to inactivate the drive devices for the upstream and downstream rollers so that the rotary separator member may separate the stationary tickets. As such, Applicants respectfully assert that irrespective of any alleged configurations in the prior art that would provide such a controller, that one of ordinary skill in the art would not consider combining such alleged prior art with Irvine to arrive at Applicants' claimed invention. Irvine teaches away from the claimed invention and any alleged prior art combination would not be obvious to one of ordinary skill.

Finally, during a personal interview with the Examiner on March 5, 2002, the issue of a controller with respect to the prior art was discussed. During that

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interview, the Examiner indicated that "favorable consideration" will be given to defining an invention which included reciting a controller to hold the tickets during the separation process. In response to that interview and the Examiner's indication of "favorable consideration," Applicants added claims 43 and 46 which each recite a controller to inactivate the drive devices and hold the ticket strip stationary during operation of the rotary separator member. Such operation is described on pgs. 11 and 12 of Applicants' specification and the controller is described on pgs. 16 and 17. As such, Applicants respectfully assert that claims 43 and 46, as well as claims dependent therefrom, are patentably novel and nonobvious over the prior art including Irvine which utilizes a bursting mechanism in which the tickets or web are moving and require tension between differing speeds of the rollers during the bursting operation. The focus of the discussion during the interview was with respect to the prior art Keeny reference. Nevertheless, both Keeny and Irvine (which has been of record in this case since being considered on September 25, 2000 by the Examiner) both utilize a bursting or cutting device on a moving web. Therefore, Applicants claimed controller which inactivates the drive devices for operation of the bursting member on a stationary web is directly applicable. Therefore, Applicants respectfully request that the Examiner honor his agreement that an invention which includes such a controller is worthy of favorable consideration.

The Office Action also acknowledges that Irvine lacks the separator member having a helical protrusion as recited in claim 42. Nevertheless, the Examiner

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takes Official notice that such a feature is old and well known. Once again, Applicants respectfully challenge this Official notice and request evidence demonstrating same.

New claim 49 has been added herein and is similar to claim 42 and Applicants respectfully assert that claim 49 is likewise allowable over the prior art of record.

Summary

As a result of the amendments to the claims and remarks given herein, Applicants respectfully assert that each of the rejections and objections identified in the Office Action have been overcome. As such, Applicants request Notice of Allowance with respect to the now pending claims at the Examiner's earliest convenience. If the Examiner feels that any matter in this case requires further attention prior to issuing a Notice of Allowance, he is asked to telephone the undersigned attorney so that the matter may be promptly resolved.

Respectfully submitted,

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